

REMARKS

Claims 89-97, 99-124 and 127 are pending in this Application. Claims 98 and 128 are canceled without prejudice or disclaimer. Claims 89, 92, 93, 107, 110, 111, 117, 120, and 121 are amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the Abstract, FIG. 2, ¶¶ [0004], [0023], [0027], and [0030] of the corresponding US Pub. No. 20070289023. Applicants submit that the present Amendment does not generate any new matter issue.

Claim 91 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

In the statement of the rejection the Examiner asserted it is not clear how to authenticate the mobile terminal via the wireless communication connection while downloading the gaming application via the data network connection as recited in claim 16, and there is no support in the specification for the recitation. This rejection is traversed.

Applicants do not agree that one have ordinary skill in the art would have difficulty ascertaining the scope of the claimed invention, particularly when interpreted in light of and consistent with the specification, such as ¶ [0030]. By way of example, a game-enabled cellular phone initiates a two-path connection between itself and a games server, by authorizing and authenticating of the software for e.g., Digital Rights Management (DRM) applications via the wireless connection while downloading the bulk gaming software via the data network connection.

Moreover, MPEP §2173.02 cautions that “[s]ome latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.

Applicants therefore solicit withdrawal of the rejection of claim 91 under the second paragraph of 35 U.S.C. §112.

Claim 128 was rejected under the first paragraph of 35 U.S.C. §112 for lack of adequate descriptive support.

In the statement of the rejection, the Examiner asserted that the concept of “determining to use the interchangeable mass storage in conjunction with different mobile terminals thereby enforcing digital right associated with the gaming application” is not described in the specification. This rejection is traversed.

Initially, literal support is not required by the statute. *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d at 923; *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566-67 (Fed.Cir.1997). An applicant need not utilize any particular form of disclosure. *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed.Cir.2008) (quoting *In re Alton*, 76 F.3d 1168, 1172 (Fed.Cir.1996)). Further, a patent applicant has the right to narrow an originally disclosed invention. *In re Johnson*, 558 F.2d 1008 (C.C.P.A.)

In applying the above legal tenets to the exigencies of this case, Applicants submit that one having ordinary skill in the art would have recognized that Applicants had possession of the claimed invention at the time the Application was filed. Applicants respectfully submit that the specification describes “a single specific mass storage” in ¶ [0023] that constitutes a “interchangeable mass storage.” In addition , ¶ [0023] recites that “a user can use an unlimited

number of backup copies that can be used only with a single specific mass storage. Thereby, a user can use a single mass storage device **with different cellular phones**, as long as the specific mass storage is operable. The serial number of the mass storage device may be transmitted via the cellular phone network to the server” “for a digital rights management (DRM).” The single specific mass storage may be a multi media card (MMC) (§ [0004]) or a SIM card (§ [0027]). Applicants therefore submit that the imposed rejection of claim 128 under the first paragraph of 35 U.S.C. §112 for lack of adequate descriptive support is not factually viable and, hence, solicit withdrawal thereof.

(1) Claims 89, 90, 94-96, 99-108, 112-118, 122-124, 127, and 128 were rejected as obvious under 35 U.S.C. §103(a) based on *Rao et al.* (US 7286502, “*Rao*”) in view of *Cochran et al.* (US 20050154787, “*Cochran*”).

(2) Claim 98 was rejected as obvious under 35 U.S.C. §103(a) based on *Rao* in view of *Cochran* and *Sawano* (US 20010039212, “*Sawano*”).

Applicants respectfully traverse these rejections.

In particular, independent claims 89, 107, and 117 recite, *inter alia*, claims 98 and 128 “determining to store the downloaded gaming application into an interchangeable mass storage, and determining **to use the interchangeable mass storage in conjunction with different mobile terminals thereby enforcing digital right associated with the gaming application.**” The above features of the independent claims are neither disclosed nor suggested by *Rao*, *Cochran*, or *Sawano*.

As admitted by the Examiner (p. 8, 3rd paragraph of the Office Action), *Rao* and *Cochran* do not “store the downloaded gaming application into an interchangeable mass storage”.

Sawano is relied upon by the Examiner to disclose such **an interchangeable mass storage**, and *Cochran* is said to provide a **different wireless device** thereby enforcing digital right of the gaming driver.

Sawano connects an interchangeable ROM-based memory cartridge that is pre-installed with a gaming application to a GAMEBOY. In particular, the gaming application was pre-installed into *Sawano*'s memory cartridge in a factory, rather than **dual-downloaded** (via wireless and data network) into a mobile terminal then into the memory cartridge. Since there is no logic reason to dual-downloading a game application into a mobile terminal then into *Sawano*'s memory cartridge, one skilled in the art would not be motivated to combine *Sawano* into the combination of *Rao* and *Cochran* as asserted by the Examiner (p. 8, 3rd paragraph of the Office Action).

Cochran's wireless device automatically detects a peripheral device (e.g., a video game device or a play pad) and requests a remote server to send a driver for the peripheral device via a wireless communications network (Abstract; ¶ [0019]). *Cochran* only requests the user to enter a password into a wireless device 103 before requesting and installing the required gaming driver (¶ [0028]). Contrary to the Examiner's assertion (p. 7, 5th paragraph of Office Action), there is no mention in ¶ [0028] of a **different wireless device**, or use of the peripheral device stored with the driver "to enforce digital right of the gaming driver" in *Cochran*. In short, *Cochran* does not use the peripheral device to enforce digital right associated with the gaming driver among different user terminals. In fact, *Cochran* teaches away from the claimed inventions by allowing only one user terminal to automatically check for availability of a new version of the driver from the remote server (Abstract).

Accordingly, even if the applied references were combined as proposed by the Examiner, and Applicants do not agree that the requisite basis for the asserted motivation has been established, the claimed inventions would not result. *See Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir.1988). Applicants therefore submit that the above-identified rejection encompassing claims 89, 90, 94-96, 98-108, 112-118, 122-124, 127, and 128 under 35 U.S.C. 103(a) for obviousness based primarily on *Rao* in view of *Cochran* and *Sawano* are not factually or legally viable and, hence, solicit withdrawal thereof.

(3) Claims 91, 109, and 119 were rejected as obvious under 35 U.S.C. §103(a) based on *Rao* in view of *Cochran* and *Zhang* (US 7239864, “*Zhang*”).

(4) Claims 92, 93, 110, 111, 120, and 121 were rejected as obvious under 35 U.S.C. §103(a) based on *Rao* in view of *Cochran* and *Skog et al.* (US 20040260816, “*Skog*”).

(5) Claim 97 was rejected as obvious under 35 U.S.C. §103(a) based on *Rao* in view of *Cochran* and *Thielke et al.* (US 6324564, “*Thielke*”).

Each of the above-referenced rejections (3)-(5) is respectfully traversed.

Claims 91-93, and 97 depend from independent claim 89; claims 109-111 depend from independent claim 107; and claims 119-121 depend from independent claim 117. Applicants submit that claims 91-93, 97, 109-111, and 119-121 are free of the applied prior art for reasons advocated *supra* with respect to independent claims 89, 107, and 117. The additional references to *Zhang*, *Skog* and *Thielke* do not cure the previously argued deficiencies in *Rao*, *Cochran*, and *Sawano*.

With respect to claim 92, *Skog* merely provides access to an IP number or a subscriber ID associated with a mobile device (Abstract), and maps an IP address to an MSISDN number (§ [0018]). There is no teaching of “a serial number of a computer readable storage medium

carrying only an initialization engine and a game communication control engine of the gaming application.”

Applicants therefore submit that the above-identified rejection encompassing claims 91-93, 97, 109-111, and 119-121 under 35 U.S.C. 103(a) for obviousness based primarily on *Rao* are not factually or legally viable and, hence, solicit withdrawal thereof.

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9952 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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